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| FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | BASHORE, WILLIAM L | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/615,781

Applicant(s)

METCALFE ET AL.

Examiner

William L. Bashore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 19-30, 32-40 and 48-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 19-30, 32-40, 48-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. This action is responsive to communications: RCE filed 9/23/2004, to the original application filed 7/13/2000 with foreign priority filing data of 7/14/1999. IDS filed 8/31/2000, 6/6/2001, 5/20/2002, and 5/29/2003. Formal drawings filed 3/26/2004.
2. Claims 1-11, 19-30, 32-40, 48-56 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Barrera and Ernst.
3. Claims 1-11, 19-30, 32-40, 48-56 pending. Claims 1, 19, 25, 32, 33, 48 are independent claims.

Continued Examination Under 37 CFR 1.114

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/23/2004 has been entered.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-11, 19-30, 32-40, 48-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrera et al. (hereinafter Barrera), U.S. Patent No. 6,567,800 issued May 2003, in view of Ernst, Warren (hereinafter Ernst), Using Netscape, 1995 Que Corporation, pages 56-57, 73-82.

In regard to independent claim 1, Barrera teaches presentation of search results from a search over a network (i.e. Internet), said search utilizing a spider to retrieve page information regarding various categories, as well as user queries, resulting in retrieval of relevant URLs (location addresses) (Barrera Abstract, column 4 lines 21-34, 59-65, column 5 lines 4-13; compare with claim 1 *"A method of presenting search results obtained from a search conducted over a computer network, said search being performed using searching criteria and returning information including a plurality of network locations, said method comprising the steps of:"*

Barrera teaches a memory (Barrera Figure 5 item 506) for storing website content correlated with categories, instructions, as well as retrieving and storing said content accordingly (see also Barrera column 3 lines 56-67 (especially line 61), and column 4 lines 1-5). It is noted that since Barrera's returned network location URLs (e.g. Barrera Figures 8-10) are part of the returned contents, said locations are stored with content for further processing accordingly.

Barrera teaches extracting various web page information (i.e. identity of author, date, textual content, etc.) (Barrera column 4 lines 25-34; compare with claim 1 *"extracting data from a first one of said network locations"*).

Barrera teaches a content keyword search request, resulting in page URLs returned including matched keywords found within each page (Barrera column 5 lines 6-11; compare with claim 1 *"examining said data to identify therein said searching criteria to provide at least one specific location within said first network location of said searching criteria"*, and *"using said one specific location to identify from said extracted data specific data including at least said searching criteria"*).

Barrera teaches formatting the display of search results within a dynamically generated web page (Barrera column 5 lines 10-16, 47-55, Figure 9). Barrera does not specifically teach that the search term(s)

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themselves (i.e. "telephone" of Barrera Figure 9) are formatted (displayed) along with retrieved information. However, Barrera teaches an embodiment whereby a search engine's query results include either the search term itself within each result (i.e. AT&T), or as close a match as possible (i.e. AT+T) (see Barrera Figure 4), providing reasonable suggestion to the skilled artisan of including "*search criteria*" within the claimed "formatted specific data". It would have been obvious to one of ordinary skill in the art at the time of the invention to interpret Barrera to include search criteria as explained above, providing a user of Barrera the benefit of displaying the context to which a search term is applied to a document.

Barrera does not specifically teach its dynamically displayed web page document as a "printable" document. However, Ernst teaches an HTML browser (Netscape) which describes printing of web pages to a printer, including display of various search engine related pages subject to printing (Ernst page 56, 80-82). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Ernst to Barrera, providing a user of Barrera the benefit of printing its search engine web page results for permanent future reference (compare with claim 1 "*formatting said specific data into a printable document*").

Barrera teaches analysis and formatting of a plurality of web page data which satisfy the necessary search criteria (Barrera column 5 lines 10-16, Figures 4, 9; compare with claim 1 "*repeating steps (a) to (d) for each remaining said network location in which step (d) incorporates said formatted data of said remaining network location to said printable document.*").

In regard to dependent claim 2, Barrera teaches various extra information associated with returned results (i.e. URL, textual content, size, etc.) (see Barrera Figures 4, 8-10, column 4 lines 26-34).

In regard to dependent claim 3, Barrera teaches graphical magnifying glass icons to the left of each returned URL, acting to help physically separate each displayed result (see Barrera Figure 9).

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In regard to dependent claim 4, Barrera teaches a spider ("Vspider") which searches a file corresponding to a URL (a root file), and identifies links from said file to other pages for eventual searching, said files and pages subject to eventual contextual formatting (see Barrera column 4 lines 21-34). Barrera also teach various categories for searching (providing context) (see Barrera Figure 9 – upper right side bullets)

In regard to dependent claim 5, Barrera teaches graphical magnifying glass icons to the left of each returned URL, acting to help physically separate each displayed result (including root data, and specific data (see Barrera Figure 9, also Barrera column 4 lines 22-34).

In regard to dependent claim 6, Barrera does not specifically teach a plurality of columns, as claimed. However, Barrera teaches parts of documents formatted as such (see Barrera Figure 7 – separation between index guide on left side, and columns formed by "Search by subject" area, columns are also demonstrated in Barrera Figures 1 and 2), providing the claimed equivalent of formatting a document into columns. It would have been obvious to one of ordinary skill in the art at the time of the invention to interpret Barrera in this fashion, providing an organized web page to a user.

In regard to dependent claim 7, Barrera teaches electronically displaying a document to a user (Barrera Figures 9-10, column 5 lines 11-16).

In regard to dependent claim 8, Barrera does not specifically teach "print preview". However, Ernst teaches an HTML browser (Netscape) which describes "print preview" of web pages, said pages including various search engine related pages subject to printing (Ernst page 57). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Ernst to Barrera, providing a user of Barrera the benefit of previewing search engine web page results, prior to printing, in order to see exactly how said results will look after printing.

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In regard to dependent claim 9, claim 9 incorporates substantially similar subject matter as claimed in claim 1, and is rejected along the same rationale.

In regard to dependent claim 10, claim 10 incorporates substantially similar subject matter as claimed in claim 1, and is rejected along the same rationale.

In regard to dependent claim 11, Barrera teaches various data extracted from web pages (Barrera column 4 lines 22-34, column 5 lines 11-16, 47-58). Since Barrera (in view of Ernst) teaches presentation/printing of search engine web page results (i.e. HTML) (see rejection of instant claim 1), Barrera's results are accordingly converted for appropriate presentation/printing.

In regard to independent claim 19, claim 19 incorporates substantially similar subject matter as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Barrera teaches a user performing a search in a series of steps (Barrera Figures 8-10). Barrera returns final hits which contain "telephone", as well as falling into the category of "AT&T" (typically sites which at least reference the word "AT&T", which can be interpreted as criteria used for instigating a search (compare with claim 19 "*... including searching criteria used to instigate said searching process;*").

In regard to dependent claim 20, Barrera teaches a spider ("Vspider") which searches a file corresponding to a URL (a root file), and identifies links from said file to other page URLs for eventual searching, said files and pages subject to eventual contextual formatting (see Barrera column 4 lines 21-34). Barrera also teach various categories for searching (providing context) (see Barrera Figure 9 – upper right side bullets). Barrera also teaches a user query resulting in specific locations (i.e. URLs, and returned sections of pages with search terms – as taught in the rejection of claims 19, and 1, above).

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In regard to dependent claim 21, Barrera also teaches a user query resulting in specific locations (i.e. URLs, and returned sections of pages with search terms – as taught in the rejection of claims 19 and 1, above, see also Barrera Figures 4, 9). It is noted that Barrera Figure 4 only displays portions of web page content including search terms, etc.

In regard to dependent claim 22, claim 22 incorporates substantially similar subject matter as claimed in independent claim 19, and in further view of the following, is rejected along the same rationale.

Barrera teaches formatting and display of a dynamically produced web page (typically HTML), which can be fairly interpreted as a predetermined format suitable for display and printing (see Barrera column 5 lines 10-16; compare with claim 22 “*format suitable for both electronic display and printing*”, and “*predetermined format*”).

In regard to dependent claim 23, claim 23 incorporates substantially similar subject matter as claimed in claim 19, and in further view of the following, is rejected along the same rationale.

Barrera teaches a spider (“Vspider”) which searches a file corresponding to a URL (a root file), and identifies links from said file to other pages for eventual searching of portions, said files and pages subject to eventual contextual formatting (see Barrera column 4 lines 21-34). Barrera also teach various categories for searching (providing context) (see Barrera Figure 9 – upper right side bullets), as well as user inputted search term query.

In regard to dependent claim 24, claim 24 incorporates substantially similar subject matter as claimed in claims 23, and 19, and is rejected along the same rationale.

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In regard to independent claim 25, claim 25 reflects the apparatus comprising computer readable instructions used in performing the method as claimed in independent claim 1, and is rejected along the same rationale.

In regard to dependent claim 26, Barrera teaches a spider ("Vspider") which searches a file corresponding to a URL (a root file), and identifies links from said file to other pages for eventual searching of portions, said files and pages subject to eventual contextual formatting and categorizing of data (see Barrera column 4 lines 21-34). Barrera also teach various categories for searching (see Barrera Figure 9 – upper right side bullets), as well as use inputted search term query.

In regard to dependent claims 27, 28, 29, 30, claims 27, 28, 29, 30 reflect the apparatus comprising computer readable instructions used in performing the methods as claimed in dependent claims 3, 4, 5, and combination of claims 7 and 9, respectively, and are rejected along the same rationale.

In regard to independent claim 32, claim 32 reflects the apparatus comprising computer readable instructions used in performing the method as claimed in independent claim 1, and is rejected along the same rationale.

In regard to independent claim 33, claim 33 reflects the computer readable medium comprising computer readable instructions used in performing the method as claimed in independent claim 1, and is rejected along the same rationale.

In regard to dependent claims 34, 35, 36, 37, 38, 39, 40, claims 34-40 reflect the computer readable medium comprising computer readable instructions used in performing the methods as claimed in claims 1, 2, 3, 4, 5, 6, 11, respectively, and are rejected along the same rationale.

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In regard to independent claim 48, claim 48 reflects the computer readable medium comprising computer readable instructions used in performing the method as claimed in independent claim 1, and in further view of the following, is rejected along the same rationale.

Barrera teaches a user performing a search in a series of steps (Barrera Figures 8-10). Barrera returns final hits which contain "telephone", as well as falling into the category of "AT&T" (typically sites which at least reference the word "AT&T", which can be interpreted as criteria used for instigating a search (compare with claim 48 "... including searching criteria used to instigate said searching process;").

In regard to dependent claim 49, Barrera teaches a spider ("Vspider") which searches a file corresponding to a URL (a root file), and identifies links from said file to other page URLs for eventual searching, said files and pages subject to eventual contextual formatting (see Barrera column 4 lines 21-34). Barrera also teach various categories for searching (providing context) (see Barrera Figure 9 – upper right side bullets). Barrera also teaches a user query resulting in specific locations (i.e. URLs, and returned sections of pages with search terms – as taught in the rejection of claims 48, and 1, above).

In regard to dependent claim 50, Barrera also teaches a user query resulting in specific locations (i.e. URLs, and returned sections of pages with search terms – as taught in the rejection of claims 48, and 1, above, see also Barrera Figures 4, 9). It is noted that Barrera Figure 4 only displays portions of web page content including search terms, etc.

In regard to dependent claim 51, claim 51 incorporates substantially similar subject matter as claimed in independent claim 48, and in further view of the following, is rejected along the same rationale.

Barrera teaches formatting and display of a dynamically produced web page (typically HTML), which can be fairly interpreted as a predetermined format suitable for display and printing (see Barrera column 5 lines

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10-16; compare with claim 51 "*format suitable for both electronic display and printing*", and "*predetermined format*").

In regard to dependent claim 52, claim 52 incorporates substantially similar subject matter as claimed in claim 48, and in further view of the following, is rejected along the same rationale.

Barrera teaches a spider ("Vspider") which searches a file corresponding to a URL (a root file), and identifies links from said file to other pages for eventual searching of portions, said files and pages subject to eventual contextual formatting (see Barrera column 4 lines 21-34). Barrera also teach various categories for searching (providing context) (see Barrera Figure 9 – upper right side bullets), as well as use inputted search term query.

In regard to dependent claim 53, claim 53 incorporates substantially similar subject matter as claimed in claims 52, and 48, and is rejected along the same rationale.

In regard to dependent claim 54, claim 54 reflects the apparatus comprising computer readable instructions used in performing the method as claimed in claim 1 (especially Ernst's teaching of Netscape browser application in the rejection of claim 1, above), and is rejected along the same rationale.

In regard to dependent claims 55, 56, Barrera teaches formation of a web page document (Barrera column 5 lines 10-16, Figure 10; compare with claim 55).

Barrera (in view of Ernst) teach printing of a document (said printing intended for use with a printer) (see the rejection of claim 1, above), therefore claim 56 is rejected along the same rationale.

Response to Arguments

7. Applicant's arguments filed 9/23/2004 have been fully and carefully considered but they are not persuasive.

Applicant argues on pages 20-21 of the amendment that Applicant's claimed invention is not necessarily associated with production of search results, but instead operates on the search result to facilitate better provision of search results to the user (amendment - bottom of page 21). The examiner respectfully notes that the initial user's choosing of a category within Barrera serves to narrow the scope of search, so that a secondary search can be applied to a group of related documents. At least in this fashion, Barrera operates on search results, fine tuning results for more accurate final results.

Applicant argues on pages 22-25 of the amendment that the cited references do not teach storing documents including network locations. The examiner respectfully notes that Barrera teaches a memory (Barrera Figure 5 item 506) for storing website content correlated with categories, instructions, as well as retrieving and storing said content accordingly. Since, Barrera's returned network location URLs are part of the returned contents, said locations are stored for further processing accordingly.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (571) 272-4088. The examiner can normally be reached on 11:30am - 8:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William L. Bashore

WILLIAM L. BASHORE
PATENT EXAMINER
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January 20, 2005